UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

| APPLICATION NO.                                      | FILING DATE                             | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |
|--|---|----------------------|---------------------|------------------|--|
| 10/520,212   | 11/04/2005                              | 04/2005 Georg Weber  |                     | 5166             |  |
|  | 7590 08/09/2007<br>DAVIDSON & KAPPEL, L | EXAMINER             |                     |                  |  |
| 485 SEVENTH AVENUE, 14TH FLOOR<br>NEW YORK, NY 10018 |   |                      | LOPEZ, FRANK D      |                  |  |
| NEW YORK,  | NY 10018                                |                      | ART UNIT            | PAPER NUMBER     |  |
| •  |   |                      | 3745                |                  |  |
|  |   |                      |                     |                  |  |
| •  |   |                      | MAIL DATE           | DELIVERY MODE    |  |
|  |   |                      | 08/09/2007          | PAPER            |  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| 441 |  |
|-----|--|
| WV. |  |

## Advisory Action Before the Filing of an Appeal Brief

| Application No. | Applicant(s) |  |  |
|-----------------|--------------|--|--|
| 10/520,212      | WEBER ET AL. |  |  |
| Examiner        | Art Unit     |  |  |
| F. Daniel Lopez | 3745         |  |  |

| <ul> <li>The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because <ul> <li>(a)</li></ul></li></ul>  |   | F. Daniel                              | Lopez  | 3745  |                           |  |  |
|--|---|--|--|---|---------------------------|--|--|
| THE REPLY FILED 23_bby_2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.  1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must threely file one of the following replies: (1) an amendment, affidavil, or other evidence, which pare the providence of the providence | The MAILING DATE of this communication a  | ppears on the                          | cover sheet with the   | correspondence add                                | ress                      |  |  |
| 1. The repty was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies; (1) an amendment, affadiant, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 1.131, or (3) a Request for Continued Examination (RCC) in compliance with 37 CFR 1.141. The repty must be filed within one of the following time periods:  a) The period for repty expires months from the mailing date of the final rejection.  b) The period for repty expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, with the statutory period for repty expires than SIX MONTH'S for the first statutory period for repty expires on: (1) the mailing date of the final rejection. Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTH'S OF THE FINAL REJECTION See IMPEPE 706 OF(1).  Extensions of time may be obtained under 37 CFR 1.136(b). The date on which the period repty amount of the final rejection. The period for repty expires of determining the period for the control of the final rejection, even if timely filed, may reduce any examined part the date for purposes of determining the period for the extension for the final rejection, even if timely filed, may reduce any examined part the mailing date of the final rejection, even if timely filed, any reduce any examined part the mailing date of the final rejection, even if timely filed and for the final rejection of Appeal and Step 1.3 (a), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the date for filing the Notice of Appeal was been filed; any repty must be filed within the time period dismissal of the date of filing the Notice of Appeal was been filed, any repty must be filed within the time peri      |   |  |  |   |                           |  |  |
| b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, with the statutory period for reply expire later than SIX MONTHS from the mailing date of final rejection. Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MEPS 708.07(f). Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been flied is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked, Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  NOTICE OF APPEAL.  2 ★** The Notice of Appeal was filed on 23 July 2007. A brief in compliance with 37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal land Seen filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  AMENDMENTS  3 ★** The Proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (a) They raise new issues that would require further consideration and/or search (see NOTE below);  (b) They raise not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d) They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE: ★** Gee 37 CFR 1.116 and 41.33(a)).  1 The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Co  | 1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following                     |  |  |   |                           |  |  |
| Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been flied is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee have been flied is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee have been flied is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.136(a) calculated from: (1) the bed the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.136(a) calculated from the feet and the state of the final rejection, even if timely filed. May reduce any earned patent term adjustment. See 37 CFR 1.704(b).  NOTICE OF APPEAL  2. The Notice of Appeal was filed on 23 July 2007. A brief in compliance with 37 CFR 41.37 (with appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  AMENDMENTS  3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (a)— They raise new issues that would require further consideration and/or search (see NOTE below);  (b)— They raise the issue of new matter (see NOTE below);  (c)— They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d)— They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE: (See 37 CFR 1.116 and 41.33(a)).  4 The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  5 Applicant's reply has overcome the following rejection(s):  | b) The period for reply expires on: (1) the mailing date of the no event, however, will the statutory period for reply exp  | his Advisory Act<br>pire later than SI | ion, or (2) the date set forth<br>X MONTHS from the mailir   | ng date of the final rejecti                      | on.                       |  |  |
| have been field is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension tee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortness distutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  NOTICE OF APPEAL  2. ▼The Notice of Appeal was filed on 23 July 2007. A brief in compliance with 37 CFR 41.37 (must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  AMENDMENTS  3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (a) They raise the issue of new matter (see NOTE below);  (b) They raise the issue of new matter (see NOTE below);  (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  (d) They present additional claims without cancelling a corresponding number of finally rejected claims.  NOTE: (See 37 CFR 1.116 and 41.33(a)).  4 The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  5 Applicant's reply has overcome the following rejection(s): (See 37 CFR 1.116 and 41.33(a)).  6 Notice of Appeal, the proposed amendment(s): a) will not be entered of filing a Notice of Appeal will not he entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  7 The affidavit or other evidence filed after a final action, but before or  | TWO MONTHS OF THE FINAL REJECTION. See MPE  | EP 706.07(f).                          |  |   |                           |  |  |
| date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).  AMENDMENTS  3.   | have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). |  |  |   |                           |  |  |
| (a)  | date of filing the Notice of Appeal (37 CFR 41.37(a)), appeal. Since a Notice of Appeal has been filed, any AMENDMENTS  | or any extens<br>reply must be         | on thereof (37 CFR 41.3 filed within the time peri   | 37(e)), to avoid dismis<br>od set forth in 37 CFR | sal of the<br>3 41.37(a). |  |  |
| (c)  | (a) They raise new issues that would require furthe   | er consideration                       | o the date of filing a brie<br>n and/or search (see NC   | f, will <u>not</u> be entered b<br>DTE below);    | ecause                    |  |  |
| (d) They present additional claims without canceling a corresponding number of finally rejected claims.  NOTE:   | (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for   |  |  |   |                           |  |  |
| 4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324). 5. ☐ Applicant's reply has overcome the following rejection(s):  | (d) They present additional claims without canceling  |  | ding number of finally re  | ejected claims.                                   |                           |  |  |
| <ul> <li>Applicant's reply has overcome the following rejection(s):</li></ul>  | 4. The amendments are not in compliance with 37 CFR   | 1.121. See at                          | tached Notice of Non-C   | ompliant Amendment                                | (PTOL-324).               |  |  |
| <ul> <li>Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</li> <li>For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:     Claim(s) allowed:     Claim(s) objected to:     Claim(s) rejected:     Claim(s) rejected:     Claim(s) withdrawn from consideration:  AFFIDAVIT OR OTHER EVIDENCE  8.</li></ul>   |   |  |  |   |                           |  |  |
| how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  Claim(s) allowed:  Claim(s) objected to:  Claim(s) rejected:  Claim(s) withdrawn from consideration:  AFFIDAVIT OR OTHER EVIDENCE  8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  /F. Daniel Lopez/Primary Examiner  | 6. Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely filed amendment canceling the   |  |  |   |                           |  |  |
| Claim(s) objected to: Claim(s) rejected: Claim(s) withdrawn from consideration:  AFFIDAVIT OR OTHER EVIDENCE  8.   | 7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  |  |  |   |                           |  |  |
| AFFIDAVIT OR OTHER EVIDENCE  8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  | Claim(s) objected to: Claim(s) rejected:  |  |  |   |                           |  |  |
| because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).  13. Other:   | AFFIDAVIT OR OTHER EVIDENCE   |  |  |   |                           |  |  |
| entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  REQUEST FOR RECONSIDERATION/OTHER  11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).  13. Other:   | because applicant failed to provide a showing of good was not earlier presented. See 37 CFR 1.116(e).   | d and sufficier                        | t reasons why the affida   | ivit or other evidence                            | s necessary and           |  |  |
| REQUEST FOR RECONSIDERATION/OTHER  11. ☑ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  See Continuation Sheet.  12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)  13. ☐ Other:  /F. Daniel Lopez/ Primary Examiner   | entered because the affidavit or other evidence failed<br>showing a good and sufficient reasons why it is nece  | d to overcome<br>ssary and was         | all rejections under apponote and and an indicate an indic | eal and/or appellant fa<br>See 37 CFR 41.33(d)(   | ils to provide a (1).     |  |  |
| <ul> <li>11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.</li> <li>12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s)</li> <li>13.  Other:</li> <li>/F. Daniel Lopez/Primary Examiner</li> </ul>   | 10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.  |  |  |   |                           |  |  |
| 13. Other:  /F. Daniel Lopez/ Primary Examiner   | 11. The request for reconsideration has been considered.  See Continuation Sheet.   |  |  | in condition for allowa                           | ince because:             |  |  |
| Primary Examiner   |   | t(s). (PTO/SB/                         | 08) Paper No(s)  |   |                           |  |  |
|  |   |  |  | Primary Examiner                                  |                           |  |  |

Continuation of 11. does NOT place the application in condition for allowance because: Applicant states "it is clear to one of ordinary skill in the art that Morita et al is speaking of conventional teeth and not specifically saw teeth". Furthermore, Morita et al asks for increasing a height (depth) if a thread, to increase joint strength, which teaches away from saw teeth as changing the shape of teeth does not strengthen the housing. And therefore, it is not obvious to combine saw teeth with Morita et al.

Applicant appears to be reading a number of things into Morita et al. Morita et al does not say anything about the shape of the threaded teeth, not even Applicant's "conventional teeth" (since even the teeth are drawn generically), and therefore does not teach for or against any shape. Applicant is clearly reading conventional teeth and only conventional teeth, into the silence of Morita et al. From this applicant reads into the statement of teeth height, that the shape of the teeth can not change. The examiner shares neither of these interpretations. The teaching of Morita et al, that increasing the height of the teeth increases the joint strength, is true of a number of different shapes, including saw teeth. Therefore, Morita et al does not teach away from using saw teeth.

Applicant appears to state that there was a long felt problem of increased joint strength in compressors. If there was a long felt need for increased joint strength in compressors, then it would not be obvious to add saw teeth to the compressors of Olson and Morita et al. But this long felt need is not supported in any way. If applicant submits real evidence of a long felt need, then this rejection would be reviewed in light of this evidence.

Morita et al does not support the view that there is a long felt need. Morita et al is actually saying that a solution of joint strength is well known, to increase either of thread height or number of threads, or both..